

Remarks/Arguments

Claim 1-12 are pending in the application. The election of claims 1-7 and 9-12 is hereby affirmed, and claim 8 is withdrawn. Claims 1-7 and 9-12 stand rejected. New claims 13-16 are added by this amendment.

Rejection Under 35 USC § 112

Claim 11 was rejected under 35 USC § 112 because the Examiner considers that it is not enabled. Reconsideration of this grounds for rejection is respectfully requested. The Examiner is kindly reminded that the specification is drafted to one of ordinary skill in the art to which the invention pertains: "Detailed procedures for making and using the invention may not be necessary if the description of the invention itself is sufficient to permit those skilled in the art to make and use the invention." MPEP § 2164.

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification (page 5, lines 14-21) on and equivalents thereof." 35 USC § 112. Applicant's disclosure of creases or molded units (see page 5, line 23 to page 8, line 1) are fully enabling of means for folding, which is by creases or moldable material. Persons skilled in the art would fully appreciate from Figs. 1a and 1b, and associated text on page 6, that the panels illustrated are folded around the desired object. As for the moldable material, persons skilled in the art would readily appreciate that the folding means are inherent in the material properties of a moldable material, in the same fashion that aluminum foil, for example, may be molded around left-over food. The original claims of an application form part of the

enabling specification. MPEP § 2164. The specification is accordingly amended to recite "means for folding". In view of the foregoing, the rejection should be withdrawn.

Rejection of Claim 1-3, 6-7, 9-12 Under 35 USC § 103(a)

Claims 1-3, 6-7, 9-12 have been rejected as obvious in view of Brady, USP 4,140,997. Applicant respectfully requests reconsideration of this grounds for rejection because a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has not identified any teaching, suggestion or motivation for the combination of (1) Brady and (2) the alleged knowledge of persons skilled in the art to install the display device on the surface of a system. MPEP 2144.03 states:

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known."

Applicant submits that the alleged knowledge for the modification of Brady did not exist at the time of the invention and requests that the Examiner provide documentary evidence supporting the rejection. For example, Brady is directed to only a display device. On the other hand, the claimed invention is directed to a display device that conforms to the surface shape of an object. There is no teaching or suggestion in Brady that the display can be conformably

applied to another object. The display system specifically taught in Brady is based on a planar display board 41 with projecting light elements. There is no teaching that board 41 would in any way be suitable for conforming to the surface of another object. The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. In *re Miki*, 816 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1980). Nothing in the cited prior art suggests that it would be desirable to modify Brady's visual display to conform to the surface of another object. All rejected claims have this limitation. Accordingly, appropriate documentation must be provided or the rejection of all claims must be withdrawn.

To help the Examiner better appreciate the nature of the present invention, claim 1 has been amended to recite that the display device is conformable to a surface shape. This limitation clearly distinguishes over the planar board of Brady, which is not disclosed to have any conformability.

Further, as to claim 4, the Examiner has cited the Chien reference. The lighting devices disclosed in that reference are three-dimensional, elongate tubular structures. (See Fig. 1C and Col. 4, lines 1-5, for example.) In contrast the lighting devices in Brady are intended for use on a baseboard 41, which supports a matrix array of light sources. See Col. 5, lines 38-50. There is no teaching or suggestion that such elongate, tubular structures would be more desirably or suitable for use than LEDs, which are discrete and inexpensive light points that may be easily arrayed and addressed in a matrix taught by Brady. By using discrete light points arrayed in a matrix, Brady achieves control over the illumination of the light sources that might not be possible with elongate tubes. Accordingly, the rejection of claim should be withdrawn for this reason, as well as for the reasons noted above as to all rejected claims.

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The rejection of claim 5 based on Ohnishi should be withdrawn for analogous reasons.

First, the Examiner has not identified any teaching or suggestion in the references for the modification of Brady. Second, there has been no explanation as to why anyone would be motivated to make the device of Brady more expensive and complicated by using Ohnishi's flat panel display technology.

New claims 13-16 are dependent from claim 1 and are therefore allowable because they include all the limitations of claim 1. In addition, the new claims recite additional limitations that further distinguish the present invention over the prior art. For example, claim 13, from which claims 14-16 depend, recites that the display device conforms to a surface in three dimensions and that the display is disposed in a thin layer. In contrast, Brady teaches a base board and appended light sources, creating a significant, non-thin profile. (See Brady, Figs. 5A and 5B.) Similarly, Chien teaches three dimensional, elongate tubes as light sources, which cannot be considered conformable in a thin layer over a surface area.

Support for the new claims is found throughout the specification, including at the following locations:

- page 5, line 3 to page 6, line 1 (conformability over three dimensions);
- page 3, lines 4-7; page 6, lines 2-13; page 7, line 21 to page 8, line 2; page 8, line 23 to page 8, line 1 (thin conformable displays); and
- page 6, lines 2-5 (organic polymers).

(In view of the foregoing reasons for distinguishing over the cited references, Applicant has not raised other possible grounds for traversing the rejections, and therefore nothing herein

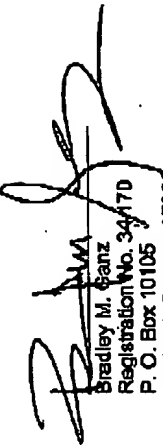
should be deemed as acquiescence in any rejection or waiver of arguments not expressed herein.)

CONCLUSION

Applicant submits that in view of the foregoing arguments and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested. The Commissioner is hereby authorized to charge any fees, including extension fees, which may be required, or credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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